

REMARKS

Claims 1-30 are pending in the application.

Claims 1-30 have been rejected.

Paragraph 0018 is amended to add registered trademark symbols. Paragraph 0040 is amended to remove reference number 100.

Paragraph 0041 is amended to accommodate the Examiner. Applicant respectfully notes that those of skill in the art recognize that a “machine-readable medium” is necessarily a “machine usable medium”, and so this language was completely supported by the specification before amendment. As the Examiner is surely aware, adequate description does not require literal support for the claimed invention. *In re Herschler*, 591 F.2d 693, 200 USPQ 711 (CCPA 1979); *In re Edwards*, 568 F.2d 1349, 196 USPQ 465 (CCPA 1978); *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976). Rather, it is sufficient if the originally-filed disclosure would have conveyed to one having ordinary skill in the art that an appellant had possession of the concept of what is claimed. *In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973). Nothing the statutes or rules requires that identical language be used, if those of skill in the art understand that the specification supports the claims.

With regard to the Examiner’s objection to the Abstract, Applicant has not amended. While Applicant recognizes that the MPEP specifies that “The language should be clear and concise and *should* not repeat information given in the title” (emphasis added), it is well known that “should” indicates an optional characteristic, as opposed to “must”. In this case, elimination of the descriptive

phrase “A system, method, and computer program product for filtering electronic mail” would actually make the Abstract *less* informative to the public, as that phrase describes the claimed embodiments in as simple language as possible. The purpose of the abstract is to enable the United States Patent and Trademark Office and the public generally to determine quickly from a cursory inspection the nature and gist of the technical disclosure, and eliminating this description would actually depart from this purpose. However, if the Examiner believes some other phrase would be more appropriate, Applicant would be happy to consider it.

Similarly, while Applicant notes the Examiner’s objection to the “Summary of the Invention”, Applicant declines to amend. Applicant first notes that a Summary is not required at all. The current Summary in paragraph 0005 concisely describes various claimed embodiments, and in no way “fits one application as well as another.” The Examiner’s specific comment, that the Summary “does not point out the advantages of the invention or how it solves problems previously existent in the prior art” is noted, but this is not a requirement of the Summary. The current Summary does, in fact, describe an advantage (*e.g.*, “filtering electronic mail ... employing automated methods to verify that the email is from either a known sender or an actual human user”), and describes specific features of the claimed embodiments. It is “commensurate with the invention as claimed”, as indicated (but not required) by 37 CFR 1.73. No “objects of the invention” are recited.

Claim 11 is amended to add a colon to accommodate the Examiner, and to delete the phrase “at least”, which is redundant of the open-ended term “comprises”. Applicant respectfully

notes that there is no requirement in the statutes or rules that a colon be included or that there should be a separate “preamble”.

The independent claims are also amended to add a feature supported in the specification, *e.g.*, at paragraph 0024. Here, if the electronic mail message includes the intro-word, then the system delivers the message and also delivers at least one previously stored message that does not include the intro-word. Paragraph 0024 indicates that any messages currently stored in the unconfirmed mailbox from that sender are delivered to the recipient’s inbox under these conditions, and these previously stored messages are ones that were stored in the “unconfirmed” mailbox because they did not include in the intro-word.

Entry of the amendments, and reconsideration of the claims is respectfully requested.

II. CLAIM REJECTION UNDER 35 U.S.C. §102 and §103

Claims 1-4, 10-14, 20-24, and 30 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,999,932 to *Paul*, hereinafter “Paul”. Claims 5-9, 15-19, and 25-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Paul in view of U.S. Publication No. 2004/0015554 to *Wilson*, hereinafter “Wilson”.

In light of the amendments above, these rejections are believed moot and are traversed.

CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining claims in the Application are in condition for allowance, and respectfully requests that this Application be passed to issue.

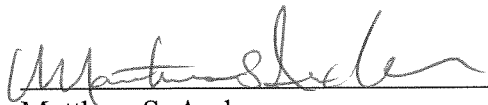
If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *manderson@munckcarter.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 05-0765.

Respectfully submitted,

MUNCK CARTER P.C.

Date: 8/27/8


Matthew S. Anderson
Registration No. 39,093

Docket Clerk/ MB-EDS
P.O. Drawer 800889
Dallas, Texas 75380
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: *manderson@munckcarter.com*